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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/599,423 01/16/96 SCHARF

A.C. 2730R

EXAMINER
MCADVOY, E

11M1/0812

THE LUBRIZOL CORPORATION
PATENT DEPT PATENT ADMINISTRATOR
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ART UNIT PAPER NUMBER

DATE MAILED: 1111

08/12/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Claim Rejections - 35 USC § 112

Claim 12 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

It is not clear how claim 12 which characterizes the lubricant composition of claim 1 as a gear oil limits the subject matter of the independent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Tipton et al (4,594,378).

Tipton et al (Tipton) teach polymeric compositions which exhibit improved shear stability in transmission and hydraulic fluids while maintaining high and low temperature viscosity

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characteristics. The polymeric compositions comprise a mixture of (A) at least one oil-soluble polymer, (B-1) at least one nitrogen-containing ester of a carboxy-containing interpolymer and/or (B-2) at least one oil-soluble acrylate polymerization product of at least one acrylate ester. The polymeric component (A) may comprise homopolymers prepared from C_3 - C_{20} monoolefins such as butene and isobutene. See col. 3, lines 4 et seq. Number average molecular weights of such polymers range from about 500 to about 100,000. See the claims. The acrylate polymerization product, component (B-2), may comprise polyacrylates (when $X=H$) and polymethacrylates (when $X=CH_3$) as set forth in col. 4, lines 25-30. Components (A) and (B-2) of Tipton clearly encompass component (A) of the instant claims which may comprise mixtures of polymer components. The polymeric compositions of the prior art may also comprise component (C), at least one low temperature viscosity-reducing liquid organic diluent such as naphthenic oil, alkylated aromatic oils and synthetic carboxylic acid ester oils. See col. 18, lines 13-57. This clearly encompasses fluidizing agent (B) of the instant claims.

The base oils used in preparing the transmission fluids and hydraulic fluids of Tipton may comprise either natural oils or synthetic oils. Mineral lubricating oils are set forth as an example of a preferred natural oil. See col. 23, lines 36 et seq. Tipton also allows for the addition of conventional lubricant

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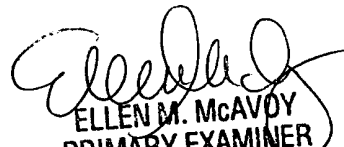
additives to the composition in conventional amounts and include detergent/dispersants, extreme pressure agents, antiwear agents and oxidation inhibitors. See col. 19, lines 24 to col. 23, top. This clearly encompasses components (C), (D) and (E) of the instant claims. Thus, the Examiner is of the position that the composition of the instant claims appears to be encompassed by the prior art to Tipton.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen McAvoy whose telephone number is (703) 308-2510.

EMcAvoy
August 7, 1996


ELLEN M. McAVOY
PRIMARY EXAMINER
GROUP 1100